

Application No.: 09/771054

Case No.: 56147US002

REMARKS

Reexamination and reconsideration of the application are respectfully requested.

The Applicant's objects to the application of finality in the recent Office Action. The prior art reference Chang was one, which clearly was of record in the present application in that it was used to previously reject the composition claims initially presented. The compositional scope of the previously presented claims was not changed in a manner which necessitated this renewal grounds for rejection based on Chang. If Chang was of concern, which it should not be, it clearly should have been applied to the claims in the first office action. The only change in the claimed subject matter was to the minor variations of the uses to which the application method claims are directed to address the claim rejections under 35 U.S.C. 101 and 112. In that Chang was clearly of record and had been previously applied the application of a final rejection to the previously presented claims reintroducing Chang as a prior art rejection is clearly inappropriate and requested withdrawn.

The rejection over Chang is also inappropriate in that Applicant's are not claiming a new use, function or property for a composition as per the in re Best case cited or the referred to MPEP sections 112.01 and 2141.02. In re Best is use in MPEP Section 2112.01 purely is relation to compositional product and apparatus claims not to method of using claims, which the present application is directed. Applicants' are not trying to reclaim a known composition. Rather what is claimed is an entirely new method of using what is alleged to be a known composition disclosed in Chang. In MPEP section 2141.02 the Examiner should be paying attention to is the section entitled DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT. The Examiner is re-characterizing the method claims to be merely a method to coat surfaces which is taught in which is allegedly the same as re-characterized teaching of Chang. However applicants are not claiming a method to generically coat "surfaces" and the teachings of Chang not to use their composition to generically coat surfaces. The object of Chang is to permanently modify the surface of a porous coating by penetrating the porous coating with it's composition and then

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to initiate cure while it is penetrated to create a durable permanent coating. Clearly looking at this actual teaching in Chang one of skill in the art would not be motivated to a method of using Changs compositions as a cosmetic article to treat a person's skin or nails. A permanent coating of the type taught in Chang for treatment of a porous substrate, such as leather, would be antithetical to the requirements of human use. Chang would actually teach away from the claimed method of using not towards it. The key is looking at the specific teachings of Chang versus what is specifically claimed and not re-characterizing the method of Chang as the claimed method as both generic methods of coating some generic surfaces.

Similarly the secondary reference Gaa adds nothing to the Chang reference. Gaa again is related to a coating which intend to be permanent, rather in this case it is made permanent by composition reacting with the surface it is coating. Again something that would be undesirable and inapplicable to treatment of a person's skin or nails.

Applicants have attached a recent decision of the PTO Board with similar facts, Ex parte Abbas, appeal number 2005-0944. In this case the claims where directed at novel method of using a child's toy , namely a method to mask a hunters scent while hunting. The toy was a propellent foam, so the only real difference was aiming the foam at a pray animal rather than another kid or the like. The art clearly did not teach this use, which like here could have been re-characterized as spraying the foam at an object.

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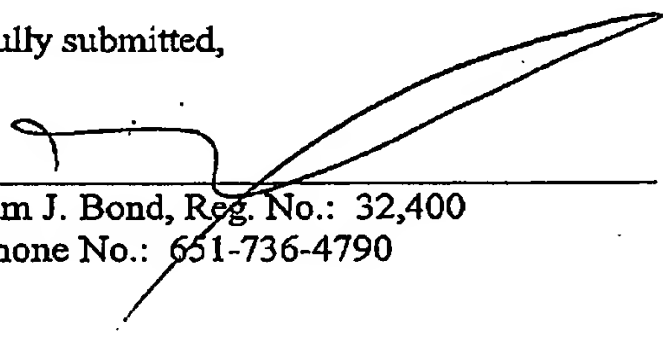
Nevertheless, we find no motivation, suggestion, or teaching in either Cox or Konietzki to make the examiner's proposed combination. While Cox suggests a method for applying the foam on "inert surfaces such as windows, walls, and the like" for play purposes (column 2, lines 63-68), such a purpose has no relation to hunting. Nothing in the applied prior art references would have led one of ordinary skill in the art to modify Cox's play method into a method for distributing [in a hunting ground] a scented chemical composition. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")

I just submitted that the application claims are allowable in their present format and in any event it is specifically requested that the finality of the rejection be withdrawn as inappropriate in view of the nature of the proceedings. Applicants also respectfully request a telephone interview be conducted for the Examiner and the Supervisor of the Application Mr. Thurman Page.

Respectfully submitted,

9/30/05
Date

By:


William J. Bond, Reg. No.: 32,400
Telephone No.: 651-736-4790

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833